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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,516

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EXAMINER

RIES, LAURIE ANNE

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

03/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/731,516	Applicant(s) JONES ET AL.	
	Examiner LAURIE RIES	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 14-17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 12, 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1-9, 16-17, and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/15/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Request for Continued Examination, filed 15 January 2009, and IDS, filed 15 January 2009, to the Original Application, filed 9 December 2003.
2. Claims 1-9, 11-12, 14-17, and 19-23 are pending. Claims 1, 11, 16, and 23 are independent claims.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 15 January 2009 was filed after the mailing date of the Original Application on 9 December 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-9, 16-17, and 19-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per independent claim 1, the language of the claim describes a method for method for representing style information in a markup language document which is not tied to a particular machine or apparatus (See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)). To qualify as a statutory process or method, a claim should positively recite the statutory class (i.e. the product or machine) to which it is tied; for example, by identifying the apparatus that accomplishes the method or process step, or the claim should explicitly recite the particular machine or apparatus, or recite a step that inherently involves the use of a particular machine or apparatus.

Claims 2-9 are dependent upon claim 8 and do not add any limitations that would render the claims statutory under 35 USC 101. Therefore, these claims are likewise rejected.

The Office respectfully suggests the following amendments to independent claim 1 to overcome the rejection of claims 8-14 under 35 U.S.C. 101:

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1. (Currently Amended)

A method for representing list information in a markup language document, comprising:

at a computing device, internally representing an application document in a word-processing application, wherein the internal representation is in a non-markup language format that is native to the application and the internal representation comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application;

at the computing device, determining one or more unique properties corresponding to a list that relates to at least one section of the application document;

at the computing device, mapping the determined properties of the list into at least one of a markup language element, an attribute, and/or a value; and

at the computing device, storing the mapped properties of the list in the markup language document, wherein the markup language document is manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document.

As per independent claim 16, the language of these claims merely describes a computer program per se. As such, this raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine to form the basis of statutory subject matter under 35 USC 101.

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One technique for satisfying the requirements of 35 USC 101 is to claim code residing in memory (i.e., hardware).

The Office respectfully suggests the following amendments to independent claim 16 to overcome the rejection of claims 8-14 under 35 U.S.C. 101:

16. (Currently Amended) A computer system for representing list definitions and instances in a markup language document, comprising:

a processor;

an application that is configured to:

internally represent an application document in a word-processing application in a non-markup language format that is native to the application and comprising unique properties for describing lists of data within the document, wherein the unique properties are defined by the application;

determine one or more unique properties relating to a list included in at least one section of the application document;

map the determined properties into at least one of a markup language element, an attribute, and/or a value; and

store the mapped properties in the markup language document, wherein the markup language document is manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document; and

a validation engine configured to validate the stored markup language document.

As per independent claim 23, the language of the claim describes a method for method for representing style information in a markup language document which is not tied to a particular machine or apparatus (See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)). To qualify as a statutory process or method, a claim should positively recite the statutory class (i.e. the product or machine) to which it is tied; for example, by identifying the apparatus that accomplishes the method or process step, or the claim should explicitly recite the particular machine or apparatus, or recite a step that inherently involves the use of a particular machine or apparatus.

The Office respectfully suggests the following amendments to independent claim 23 to overcome the rejection of claims 8-14 under 35 U.S.C. 101:

23. (Currently Amended) A method for representing list information in a markup language document, comprising:

at a computing device, inputting an application document that has been generated by a word-processing application that uses a non-markup language file

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format that is specific to the application, wherein the file format comprises unique properties of lists, wherein the unique properties are defined by the application;

at the computing device, determining one or more unique properties corresponding to a list that relates to at least one section of the application document;

at the computing device, mapping the properties of the list into at least one of a markup language element, an attribute, and/or a value; and

at the computing device, storing the properties of the mapped list properties in the markup language document whereby applications different from the application can understand the mapped list properties stored in the markup language document manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document.

Allowable Subject Matter

5. Claims 11-12 and 14-15 are allowed.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton, can be reached at (571) 272-4137.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laurie Ries/
Primary Examiner
Technology Center 2100
21 March 2009